

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-2, 5-8, 12, 25-26, 29-33, and 36 are requested to be cancelled.

Claims 3, 4, 9, 27, and 28 have been rewritten in independent form. Claims 3 and 27 have also been amended.

Claims 10, 11, 34, and 35 are currently being amended.

Claims 37-47 are being added.

After amending the claims as set forth above, claims 3-4, 9-11, 13-24, 27-28, 34-35, and 37-47 are now pending in this application of which Claims 3, 4, 9, 13, 27, 28, 37, 41, and 45 are independent.

**Change in Attorney Docket Number**

The attorney docket number for this application has changed. The new number is "15-IS-5297(066243-0209)." If it is possible to change the attorney docket number so that future communications from the Patent Office would reflect the new number, Applicants would appreciate it very much if the number would be changed.

**Rejection of Claims 1-5, 8-9, 13-17, 20-21, 25-29, and 32-33 under 35 U.S.C. § 102(b)**

In section 2 of the Office Action Claims 1-5, 8-9, 13-17, 20-21, 25-29, and 32-33 were rejected under 35 U.S.C. § 102(b) as anticipated by US Pat No 5,367,698 issued to Weber et al (hereinafter Weber '698). Claims 1-2, 5, 8, 25-26, 29 and 32-33 have been cancelled without prejudice. Claims 3-4, 9, 13-17, 20-21, and 27-28 recite limitations not taught or suggested by Weber '698.

*Claim 3*

Claim 3 was rejected on page 2 of the Office Action. Claim 3 has been amended to recite “wherein the saving step includes saving changes made by a user to the unload file including at least one of display settings and user viewing settings.” In other words, when a file is unloaded from the memory of the workstation, settings relating to the display of the file data are stored in the workstation. The Office Action recites that Weber ‘698 discloses this feature at Col. 6, lines 50-55. It is believed that the Office Action meant to reference Col. 5, lines 50-55. Weber ‘698 does not disclose this feature at Col. 6, lines 50-55 or at Col. 5, lines 50-55. Rather, Weber ‘698 discloses that when files are migrated, directory information is maintained on the local disks. See also Col. 5, lines 41-44. The location of a file in a directory is unrelated to the manner in which the actual data of the file is displayed as recited in Claim 3. Further, Weber ‘698 would not suggest saving display settings or user viewing settings because Weber ‘698 never appears to contemplate migrating files which are currently being displayed. Examples of the migration system contemplated by Weber ‘698 can be found at Col. 6, lines 18-31.

*Claim 4*

Claim 4 was rejected on page 2 of the Office Action. Claim 4 recites “reloading the unload file onto the workstation from a server, and presenting the unload file in an identical form as last presented to the user before the unloading step by utilizing the settings from the saving step, thereby the user perceiving the unload file to have been virtually open throughout.” The Office Action recites that Weber ‘698 discloses this feature at Col. 5, lines 41-48. Weber ‘698 does not disclose this feature at Col. 5, lines 41-48. Rather, Weber ‘698 discloses that when files are migrated, directory information is maintained on the local disks. The directory files are a list of closed files, not an opened file. Since the directory list is not a display of an opened file, the directory list cannot satisfy the criteria “the user perceiving the unload file to have been virtually open throughout” because there was no open file which can appear to have been open. Further, Weber ‘698 would not suggest saving settings relating to keeping a file as if it appeared open because Weber ‘698 never appears to contemplate

migrating files which are currently open. Examples of the migration system contemplated by Weber '698 can be found at Col. 6, lines 18-31.

*Claim 9*

Claim 9 was rejected on page 3. Claim 9 recites "the prioritization scheme designates a higher priority to one of the user selected files that is a currently being used file than to each of the user selected files that comprise a part of a using stack." The Office Action does not explicitly state that Weber '698 teaches this element, but appears to imply that this element is taught at Col. 6, lines 3-10. Weber '698 never teaches or suggests prioritizing files based on whether the file is currently being used or whether it is part of a using stack. Rather, Col. 6, lines 3-10 of Weber '698 is directed to a discussion of watermarks which are levels which the system will optimally empty to or at which the system will automatically start migrating files. Weber '698 would also not suggest this limitation of Claim 4 to one of ordinary skill in the art since Weber '698 is directed to migrating inactive files, such as files that have not been referenced in over 30 days, rather than active files. See Col. 2, lines 6-12 and Col. 5, lines 39-41.

*Claims 13-17 and 20-21*

Claim 13 was rejected on page 2 of the Office Action. Claim 13 recites "means for prioritizing the user selected files using a prioritization scheme." Claim 13 is interpreted under 35 U.S.C. § 112, sixth paragraph. The Office Action states that Weber '698 teaches this feature at Col. 5, line 40. Weber '698 does not teach a structure for prioritizing that is the same or equivalent to the structures for prioritizing found in the present application. Rather, Weber et al. teaches migrating the least active files to the migration server. Col. 5, lines 39-41. Claims 13-17 and 20-21 depend from Claim 13 and would be allowable for at least the same reason as Claim 13.

*Claim 27*

Claim 27 was rejected on page 2 of the Office Action for the same reasons as Claim 3. Claim 27 has limitations similar to Claim 3 and is allowable for at least the reasons discussed above with respect to Claim 3.

*Claim 28*

Claim 28 was rejected on page 2 of the Office Action for the same reasons as Claim 4. Claim 28 has limitations similar to Claim 4 and is allowable for at least the reasons discussed above with respect to Claim 4.

*Conclusion*

Since Weber '698 does not teach or suggest a limitation found in Claims 3-4, 9, 13-17, 20-21, and 27-28, Weber '698 does not anticipate or render obvious Claims 3-4, 9, 13-17, 20-21, and 27-28.

**Rejection of Claims 6-7, 10-11, 18-19, 22-23, 30-31, and 34-35 under 35 U.S.C. §103(a)**

In section 2 of the Office Action on page 3, Claims 6-7, 10-11, 18-19, 22-23, 30-31, and 34-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weber '698. Claims 6-7 and 30-31 have been cancelled.

*Claims 10 and 11*

Claims 10 and 11 were rejected on page 4 of the Office Action. Claims 10 and 11 (as amended) depend from Claim 37 which recites "wherein the prioritization scheme gives priority to a first file over a second file based on the relationship of the first file to a third file, the third file having a higher priority than the first file and the second file." As recognized in the Office Action, Weber '698 does not discuss prioritizing a file based on its relation to another, higher priority, file.

Applicant's understand the examiner's position to be that a stack of files is known in the art; that some files (such as the audio and video files of Kimura – U.S. Pat. No. 6,501,905) are opened together (making them related); and thus it would have been obvious to modify Weber '698 to give priority to related files.

Applicants respectfully disagree with this particular reasoning, especially as it relates to the clarified wording found in Claim 37. Weber '698 discloses migrating the least active files. Further, Weber '698 does not suggest migrating files that are related. Further still, if the audio and video files of Kimura are opened together, then the two files would be as active as each other and thus, when applying the least active scheme of Weber '698, would have a similar priority. One of ordinary skill in the art would not think to prioritize a first file higher than a second file based on the first file's relationship to the third file having a higher priority than the first file, especially in the system of Weber '698 which appears to be targeted at systems having files that have not been used in 30 days. See Col. 2, lines 6-12 and Col. 5, lines 39-41.

*Claims 18-19 and 22-23*

Claims 18-19 and 22-23 were rejected on pages 3 and 4 of the Office Action. Claims 18-19 and 22-23 depend from Claim 13. As discussed above, Weber '698 does not teach or suggest a limitation of Claim 13. Specifically, Weber '698 does not teach or suggest "means for prioritizing the user selected files using a prioritization scheme." Thus, Claims 18-19 and 22-23 are believed to be allowable for at least the same reasons as Claim 13.

*Claims 34 and 35*

Claims 34 and 35 were rejected on page 4 of the Office Action for the same reasons as Claims 10 and 11 respectively. Claims 34 and 35 have limitations similar to Claims 10 and 11 and are allowable for at least the reasons discussed above with respect to Claims 10 and 11.

*Conclusion*

Since Weber '698 does not teach or suggest a limitation found in Claims 10-11, 18-19, 22-23, and 34-35 and the limitation is not inherent in the art, Weber '698 does not render obvious Claims 10-11, 18-19, 22-23, and 34-35.

**Rejection of Claims 12, 24, and 36 under 35 U.S.C. § 103(a)**

In section 3 of the Office Action, Claims 12, 24, and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber '698 in view of US Pat No 6,501,905 issued to Kimura (hereafter Kimura '905). Claims 12 and 36 have been cancelled. Claim 24 recites an element not taught or suggested by Weber '698, Kimura '905, or by the combination of the references.

Claim 24 was rejected on pages 5 of the Office Action as applied to Claim 13 and further in view of Kimura '905. Claim 24 depends from Claim 13. As discussed above, Weber '698 does not teach or suggest a limitation of Claim 13. Specifically, Weber '698 does not teach or suggest "means for prioritizing the user selected files using a prioritization scheme." Kimura '905 also fails to teach or suggest "means for prioritizing the user selected files using a prioritization scheme." Further, the combination of Weber '698 and Kimura '905 fail to teach this element of Claim 24. Thus, Claim 24 is believed to be allowable over Weber '698 in view of Kimura '905.

**New Claims**

Claims 37-47 have been added. Claims 37-47 are supported by the specification as filed. Claims 37-47 are believed to be in condition for allowance.

The allowability of Claims 37 and 41 was discussed above with respect to Claims 10 and 11. Claims 38-40 depend from Claim 37 and Claims 42-44 depend from Claim 41 and would be allowable for at least the same reasons as the Claim from which they depend.

Claim 45 is believed to be allowable over the prior art of record since Claim 45 recites "saving display settings of the unloaded image such that if the unloaded image is not closed and a user decides to redisplay the unloaded image, the unloaded image appears to the user as if the unloaded image had not been unloaded" and for the reasons discussed above with respect to Claims 3 and/or 4. Claims 46 and 47 depend from Claim 45 and are believed to be in condition for allowance for at least the same reasons as Claim 45.

### **Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

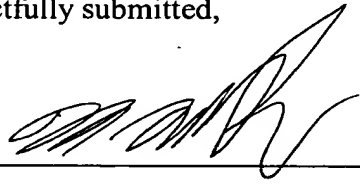
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2401. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 50-2401. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2401.

Respectfully submitted,

Date 11/4/03

By 

FOLEY & LARDNER  
777 East Wisconsin Avenue, Suite 3800  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5839  
Facsimile: (414) 297-4900

Marcus A. Burch  
Attorney for Applicant  
Registration No. 52,673